

REMARKS

This Amendment is submitted in reply to the non-final Office Action mailed on March 24, 2006. No fee is due in connection with this Amendment. The Director is authorized to charge any additional fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 117682-3 on the account statement.

Claims 1-22 are pending in this application. In the Office Action, Claim 2 is rejected under 35 U.S.C. §112, second paragraph and Claims 1-22 are rejected under 35 U.S.C. §103. In response Claims 1, 6, 9-10, 12-16 and 21-22 have been amended, Claims 2, 11 and 18 have been canceled and Claims 23-26 have been added. This amendment does not add new matter. In view of the amendments and/or for the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

Claims 6, 10 and 12-15 have been amended to correct informalities. Claims 1, 9, 16 and 21 have been amended to recite, in part, that mineral particles further comprise at least one component selected from the group consisting of magnesium, silicate and combinations thereof. This amendment is supported in the specification, for example, at page 6, lines 22-29. Claims 23-26 have been newly added. The new claims are fully supported in the specification, for example, at page 6, line 4 to page 7, line 15. No new matter has been added by any of the amendments. Accordingly, Applicants respectfully submit that these claims be allowed.

In the Office Action, Claim 2 is rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In response, Claim 2 has been canceled thereby rendering moot this rejection. Accordingly, Applicants respectfully request that the rejection of Claim 2 under 35 U.S.C. §112 be withdrawn.

In the Office Action, Claims 1-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,462,983 to Bloembergen et al., ("*Bloembergen*") in view of U.S. Patent No. 4,045,418 to Sinclair ("*Sinclair*") and U.S. Patent No. 6,136,905 to Suzuki et al. ("*Suzuki*"). Applicants believe this rejection is improper and respectfully traverse it for at least the reasons set forth below.

Independent Claims 1, 9, 16 and 21 are directed, in part, to a biodegradable composition comprising between 40 and 97% by weight of poly(lactic acid) polymer, and between 0.5 and

35% by weight of co-polyester polymer with adipic acid, and between 1 and 32% by weight of mineral particles, comprising magnesium silicate. In contrast, Applicants respectfully submit that there is no suggestion or motivation to combine the cited references to obtain the present claims, and even if combinable, all of the claimed elements are not taught or suggested by the cited references.

Applicants respectfully submit that there is no suggestion or motivation to combine the cited references to obtain the present claims. For example, *Bloembergen* is directed to compositions made of specific starch esters blended with a biodegradable polyester. See, *Bloembergen*, column 6, lines 33-38. Co-polyester polymers with adipic acid are not disclosed in the list of possible co-ingredients. In addition, the selected components are merely blended, heated and extruded without addition of any co-reactant, especially any organic peroxide. *Bloembergen* neither teaches nor suggests that such an addition should have any effect in terms of structure or physical properties of the end polymer material. As a result, *Bloembergen* is deficient with respect to the present claims.

Sinclair and *Suzuki* fail to remedy the deficiencies of *Bloembergen*. *Sinclair* is directed to copolymer compositions that may be fabricated into films, fibers or structural shapes and are made by co-polymerization of an optically inactive lactide in the presence of a tin ester of carboxylic acid. See, *Sinclair*, column 2, lines 41-68. D,L-lactide is a monomer and not a copolymer. Because *Sinclair* starts with a monomer and not a polymer, it teaches away from combinations with *Bloembergen* and *Suzuki*.

Suzuki is directed to a lactic acid polymer composition comprising L-lactic acid polymer and a plasticizer. See, *Suzuki*, column 2, lines 58-67. *Suzuki* fails to teach inclusion of mineral particles or addition of organic peroxides during processing thereby rendering *Suzuki* deficient with respect to the present invention. Consequently, because *Bloembergen*, *Sinclair* and *Suzuki* are each directed to different resulting compounds and methods of making same (each of which is distinguishable from the present invention), one having ordinary skill in the art would not be motivated to combine the cited references to arrive at the present claims. At the very least, there is no reasonable expectation of success that the cited references could be combined to arrive at the present claims.

Applicants also respectfully submit that, even if combinable, the cited references do not disclose or suggest all of the claimed elements. For example, *Bloembergen* fails to disclose or

suggest a composition comprising between 0.5 and 35% by weight of co-polyester polymer with adipic acid as required, in part, by the present claims. Instead, *Bloembergen* only discloses using an adipic acid ester as a plasticizer, which is a compound distinguishable from adipic acid. Further, *Bloembergen* fails to teach using between 0.5 and 35% by weight of co-polyester polymer along with the adipic acid.

Sinclair fails to disclose or suggest a composition comprising between 0.5 and 35% by weight of co-polyester polymer with adipic acid as required, in part, by the present claims. Similarly, *Suzuki* fails to disclose or suggest, a composition comprising between 0.5 and 35% by weight of co-polyester polymer with adipic acid as required, in part, by the present claims. In fact, *Sinclair* and *Suzuki* fail to disclose or suggest the use of adipic acid anywhere in their specifications.

What the Patent Office has done is to rely on hindsight reconstruction of the claimed invention. Applicants respectfully submit that it is only with a hindsight reconstruction of Applicants' claimed invention that the Patent Office is able to even attempt to piece together the teachings of the prior art so that the claimed invention is allegedly rendered obvious. Instead, the claims must be viewed as a whole as defined by the claimed invention and not dissected into discrete elements to be analyzed in isolation. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983); *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995). One should not use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d at 1075. (Fed. Cir. 1988).

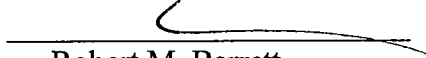
For at least the reasons discussed above, the combination of *Bloembergen* in view of *Sinclair* and *Suzuki* is improper. Moreover, even if combinable, *Bloembergen*, *Sinclair* and *Suzuki* do not teach, suggest, or even disclose all of the elements of the present claims, and thus, fail to render the claimed subject matter obvious.

Accordingly, Applicants respectfully request that the obviousness rejection with respect to Claims 1-22 be reconsidered and the rejection be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

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